In The United States Patent Office

In re Application of Juan Luis HANCKE *et al.*, *Diterpenic Lambdanes…*	Art Unit 1625 Serial No. 10/516,500 Filed 3 February 2004
	RULE 41.43(b) SUPPLEMENTAL REPLY BRIEF

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INTRODUCTION

This SUPPLEMENTAL REPLY BRIEF is submitted in response to the Examiner's SUPPLEMENTAL ANSWER (Oct. 24, 2007). This SUPPLEMENTAL REPLY BRIEF is submitted pursuant to 37 C.F.R. § 41.43(b). This SUPPLEMENTAL REPLY BRIEF is filed within two months of the Examiner's SUPPLEMENTAL ANSWER. This paper is thus respectfully believed timely filed.

The Examiner attempts to introduce three newly-cited references into the record. *See Notice of References Cited* (24 October 2007). The Examiner, however, has withheld these references until the end of briefing for this appeal. Applicant respectfully notes that this is not permissible because: (a) it is prohibited by 37 C.F.R. § 41.33; and (b) the Examiner's newly-cited references fail to qualify as prior art by several years. We discuss each reason in turn.

Rule 41.33(d)(2) Prohibits The Parties From Introducing New Evidence After The Appeal Brief Has Been Filed

The Examiner would like to introduce new evidence in the Examiner's SUPPLEMENTAL ANSWER. This is after the filing of an appeal brief.

The ability to introduce new evidence after filing an appeal brief is governed by 37 C.F.R. § 41.33(d)(2). Rule 33(d) provides:

> (d)(1) An affidavit or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and *prior to the date of filing an appeal brief* pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.
>
> (2) All other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

37 C.F.R. § 41.33(d) (italics mine).

In the instant case, the Examiner is not trying to introduce new evidence "prior to the date of filing an appeal brief," but well after. Thus, the ability to introduce this new evidence is governed by 37 C.F.R. § 41.33(d)(2).

Subsection (2) says that new evidence "will not be admitted" except in three specific situations: if the Applicant asks to reopen prosecution in response to a new ground for rejection in the Examiner's Answer, *see* § 41.39(b)(1); if the Applicant asks to reopen prosecution in response to a remand from the Board, *see* § 41.50(a)(2)(i); or if the Applicant asks to reopen prosecution in response to a new ground for rejection in the Board's decision, *see* § 41.50(b)(1). In each case, Rule 33 permits new evidence only during prosecution before the Examiner, not during an appeal to the Board.

The instant case does not qualify because this is an appeal before the Board, not prosecution before the Examiner. Significantly, the Examiner does not dispute that Rule 33 bars the new evidence. *Cf.* Examiner's SUPPLEMENTAL ANSWER (Oct. 24, 2007).

Rule 33 is fair because it requires all factual evidence to be raised during prosecution. This affords the opposing party the opportunity to introduce into the record rebuttal evidence. In the instant case, the Examiner does not dispute that the Applicant cannot introduce new evidence to rebut the Examiner's new evidence. *Cf.* Examiner's SUPPLEMENTAL ANSWER (Oct. 24, 2007). Because Applicant is barred from introducing rebuttal evidence, it is fair to also bar the Examiner from introducing her new evidence.

The Examiner's Newly-Proffered Evidence Does Not Qualify as Prior Art

Assuming that the parties were allowed to introduce new art during an appeal, the Examiner's newly-cited references fail to qualify as prior art.

The claims stand rejected under 35 U.S.C. § 102(b). To qualify as prior art under § 102(b), the art must have been published more than one year before the effective filing date of the application at hand. *See* 35 U.S.C. § 102(b).

In the instant case, the application claims an effective filing date of February 3, 2004. Thus, the critical date for prior art is February 3, 2002.

The *Notice of References Cited* (Oct. 2007) attempts to introduce Frederick F. Samaha *et al.*, Vasantha M. Nayagam *et al.* and a web page from familydoctor.org. Samaha *et al.*, however, was published in March, 2006; Nayagam *et al.* was published sometime after August 28, 2006, and the web page from familydoctor.org was published on November 2006. None of these are dated early enough to show what was known in the art before February 3, 2003.

The Examiner's SUPPLEMENTAL ANSWER (Oct. 24, 2007) also includes a fourth newly-cited reference, a web page from the MedlinePlus® Medical dictionary. Applicant respectfully notes that this reference must be disregarded because (a) the Examiner has never bothered to introduce this reference into the record, and (b) it is dated 2005, and therefore fails to show what was known in the art before February 3, 2003.

The EXAMINER'S ANSWER (at page 12) also relies on alleged "NIH website" web pages. Applicant objected because the Examiner refused to make these alleged web pages of record in this proceeding, nor even provide Applicant (and the Board) with copies of these alleged web pages. The Examiner now

continues to refuse to provide copies in her newly filed *Notice of References Cited* (Oct. 2007).

Applicant respectfully requests the Board reverse all pending rejections and order the Examiner to issue a NOTICE OF ALLOWANCE.

Respectfully submitted on behalf of the Applicant by its attorneys,
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